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## TRANSMITTAL FORM

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Total Number of Pages in This Submission

23

Application Number

10/665,256

Filing Date

09/20/2003

First Named Inventor

SHREE KURUP

Art Unit

3711

Examiner Name

MS. LEGESSE

Attorney Docket Number

KURUP-3

### ENCLOSURES (Check all that apply)



Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)



Reply to Missing Parts/  
Incomplete Application



Reply to Missing Parts  
under 37 CFR 1.52 or 1.53



Drawing(s)



Licensing-related Papers



Petition



Petition to Convert to a  
Provisional Application



Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) \_\_\_\_\_



Landscape Table on CD



After Allowance Communication to TC



Appeal Communication to Board  
of Appeals and Interferences



Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)



Proprietary Information



Status Letter



Other Enclosure(s) (please identify  
below):

Remarks

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

ROBERT NATHANS

Signature

Printed name

ROBERT NATHANS

Date

11/20/2008

Reg. No.

19,558

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4618).

## FEE TRANSMITTAL For FY 2006

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)270

### Complete if Known

Application Number	10/665256
Filing Date	09/20/2003
First Named Inventor	KURUP
Examiner Name	MJ. LEGESSE
Art Unit	3711
Attorney Docket No.	KURUP-3

### METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

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### FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

#### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

#### 2. EXCESS CLAIM FEES

Fee Description				Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)				50	25
Each independent claim over 3 (including Reissues)				200	100
Multiple dependent claims				360	180
<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	
- 20 or HP =	x	=		<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
HP = highest number of total claims paid for, if greater than 20.					
<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>		
- 3 or HP =	x	=			
HP = highest number of independent claims paid for, if greater than 3.					

#### 3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(c)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	=	

#### 4. OTHER FEE(S)

Non-English Specification. \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): APPLC BRIEF

Fees Paid (\$)

270

#### SUBMITTED BY

Signature	<u>[Signature]</u>	Registration No. (Attorney/Agent)	<u>19558</u>	Telephone	<u>9786673060</u>
Name (Print/Type)	<u>ROBERT NATHANS</u>			Date	<u>11/20/08</u>

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Shree Kurup

Group art unit: 3711

Application no. 10/665,256

Examiner: Nina Legesse

Filed 09/20/2003

NOVELTY FRAMELESS EYEWEAR FOR PROMPTING  
SOCIABILITY

BRIEF ON APPEAL

11/24/2008 HDESTA1 00000028 10665256

01 FC:2402

270.00 0P

## **THE REAL PARTY IN INTEREST**

**The real party in interest is the inventor Shree Kurup**

**RELATED APPEALS OR INTERFERENCES**

**None.**

# **STATUS OF CLAIMS**

**Claims 41-49, 55 and 56, the claims on appeal, all stand rejected under 35 U.S.C. 103(a).**

**STATUS OF AMENDMENTS**

**None**

## BRIEF SUMMARY OF THE INVENTION

A method is provided for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses comprising the steps of:

(a) providing such person seeking to attract attention at socially interactive events with a flexible frameless eye patch with an aperture therein sufficient to enable said person to see through the aperture, and with a first adhesive layer on a first side of said flexible frameless eye patch for affixing said flexible frameless eye patch directly upon said person's face to maintain said eye patch in place during vigorous social activity and having a second adhesive layer on a second side of said flexible frameless eye patch adjacent said aperture for supporting an optical element upon said flexible frameless eye patch and over said aperture;

(b) placing an attention getting message of a type that invites social interaction and that is not a trademark or logo upon said second adhesive layer of said flexible frameless eye patch; and

(c) mounting an optical element over said aperture and upon said second adhesive layer on the second side of said flexible frameless eye patch.

The attention getting message is preferably a comic saying or flirtatious conversation piece message.

The optical element can be an old discarded corrective eyeglass lens belonging to said person, for creating a new use of said old discarded corrective eyeglass lens.

## SUMMARY OF CLAIMED SUBJECT MATTER



41. A method for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses comprising the steps of:

(a) providing a person seeking to attract attention at socially interactive events with a flexible frameless eye patch with an aperture therein (fig. 1, 1, 9, spec. p. 3, ll. 11-16) sufficient to enable said person to see through the aperture, and with a first adhesive layer on a first side of said flexible frameless eye patch (fig. 2, 3, spec. p. 3, ll. 12-16) for affixing said flexible frameless eye patch directly upon said person's face to maintain said eye patch in place during vigorous social activity (spec. p. 1, para. 1; p. 2, l. 4.) and having a second adhesive layer on a second side of said flexible frameless eye patch (fig. 2, 7, spec. p. 3, ll. 15-16; p. 2, para. 2, l. 7 re "flexible") adjacent said aperture for supporting an optical element upon said flexible frameless eye patch and over said aperture;

(b) placing an attention getting message of a type that invites social interaction and that is not a trademark or logo (fig. 1, 13, spec. p. 4, ll. 1-3) upon said second adhesive layer of said flexible frameless eye patch; and

(c) mounting an optical element (fig. 2, 11, spec. p. 3, ll. 15-18) over said aperture and upon said second adhesive layer on the second side of said flexible frameless eye patch.

42. The method of claim 41 wherein the attention getting message is a comic saying or flirtatious conversation piece message (fig. 1, 13, spec. p. 3 last line).

43. The method of claim 41 wherein said optical element is an old discarded corrective eyeglass lens (fig. 1, 11, spec. p. 3, ll. 16-18) belonging to said person, for creating a new use of said old discarded corrective eyeglass lens.

44. The method of claim 42 wherein said optical element is an old discarded corrective eyeglass lens (fig. 1, 11, spec. p. 3, ll. 16-18) belonging to said person, for creating a new use of said old discarded corrective eyeglass lens.

45. The method of claim 41 wherein step (b) is performed by attaching a label (fig. 1, 13, spec. p. 4, ll. 1-3) bearing said message upon said second side of said flexible frameless eye patch.

46. The method of claim 42 wherein step (b) is performed by attaching a label (fig. 1, 13, spec. p. 4, ll. 1-3) bearing said message upon said second side of said flexible frameless eye patch.

47. The method of claim 43 wherein step (b) is performed by attaching a label (fig. 1, 13, spec. p. 4, ll. 1-3) bearing said message upon said second side of said flexible frameless eye patch.

48. The method of claim 44 wherein step (b) is performed by attaching a label (fig. 1, 13, spec. p. 4, ll. 1-3) bearing said message upon said second side of said flexible frameless eye patch.

49. A method for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses comprising:

(a) providing a person seeking to attract attention at said socially interactive events with a flexible frameless eye patch (fig. 1, 1, 9, spec. p. 3, ll. 11-16) having an attention getting device thereon (fig. 1, 13, spec. p. 4, ll. 1-3), and having an aperture therein sufficient to enable said person to see through the aperture (fig. 1, 1, 9, spec. p. 3, ll. 11-16), and with a first adhesive layer on a first side of said flexible frameless eye

patch (fig. 2, 3, spec. p. 3, ll. 12-16) , for affixing said flexible frameless eye patch directly upon said person's face to maintain said eye patch in place during vigorous social activity (spec. p. 1, para. 1; p. 2, l. 4 ) and having a second adhesive layer upon a second side of said flexible frameless eye patch adjacent said aperture (fig. 2, 7, spec. p. 3, ll. 15-16; p. 2, para. 2, l. 7 re "flexible") for supporting an optical element upon said flexible frameless eye patch; and

(b) mounting an old discarded corrective eyeglass lens (fig. 2, 11, spec. p. 3, ll. 16-18) belonging to said person upon said second adhesive layer and over said aperture, for creating a new use of said old discarded corrective eyeglass lens.

55. A method for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses, comprising:

(a) providing a person seeking to attract attention at socially interactive events with a frameless eye patch with an aperture therein sufficient to enable said person to see through the aperture (fig. 1 and 2, 9, spec. p. 3, l. 16) and with a first fastening device (fig. 2, 3; spec. p. 3, ll. 12-16) for affixing said frameless eye patch directly to said person's face to maintain said eye patch in place during vigorous social activity (spec. p. 1, para. 1; p. 2, l. 4 ) and having a second fastening device (fig. 2, 7, spec. p. 3, ll. 15-16) for supporting an optical element upon said frameless eye patch;

(b) placing an attention getting message of a type that invites social interaction and that is not a trademark or logo upon the second side of said eye patch (fig. 1, 13, spec. p. 4, ll. 1-3) 1, 13 ; and

(c) mounting an optical element over said aperture and upon the second side of said eye patch (fig. 2, 11, spec. p. 3, ll. 16-18) , wherein said optical element is an old discarded corrective eyeglass lens belonging to said person for creating a new use of said old discarded corrective eyeglass lens.

56. The method of claim 55 wherein said second fastening device (fig. 2, 7, spec. p. 3, ll. 15-16) constitutes an adhesive layer.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

**The claims on appeal stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chunga, 3758202 in view of Mack 5764338.**

## ARGUMENT

### CLAIM 41

A method for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses comprising the steps of:

(a) providing a person seeking to attract attention at said socially interactive events with a flexible frameless eye patch having an attention getting device thereon and having an aperture therein sufficient to enable said person to see through the aperture, and with a first adhesive layer on a first side of said flexible frameless eye patch for affixing said frameless eye patch directly upon said person's face to maintain said eye patch in place during vigorous social activity and having a second adhesive layer upon a second side of said flexible frameless eye patch adjacent said aperture for supporting an optical element upon said flexible frameless eye patch.....

Neither Chunga nor Mack can properly be said to disclose the invention as recited above, as the examiner asserts, since the above underlined phrases are absent from the references and particularly point out applicant's objective and its solution, not suggested by the references. These references teach away from the underlined claim language because the eyeglasses of both references would tend to fall off during dancing and swimming and thus would be ignored and not be useful by the worker in the art dealing with applicant's recited objective. None suggest flexible frameless eye patches (claims 41, 49), which are not eyeglasses as this term would be understood by the worker in the art, for affixing the lens directly upon the person's face to keep the patch in place during vigorous social activity also as specified by the method claim underlining above. Additionally, people self-conscious about wearing conventional eyeglasses, would not consider eyeglasses of the references, and thus they teach away from applicant's stated objective for this reason also, and would be ignored by the worker in the art.

The examiner states that swimming and dancing are not recited in the claims. They need not be, as all independent method claims specify vigorous social activity which would be read in the light of the specification to include dancing and swimming. Spec. page 1, para 1, ll. 3-5 refers to "vigorous dancing." whereby eyeglass temples can be dislodged.

In addition, as this Honorable Board is aware, advantages of the present invention need not be set forth in the claims or even the specification. In re Chu, 36 USPQ2nd 1089, 1095.

Also, there is no reasonable expectation of success required by MPEP 2143 in making the combination proposed by the examiner to achieve applicant's clearly stated objective of inviting social interaction by securing the messages upon eye patches during vigorous activity by virtue of using applicant's claimed lens bearing eye patch rather than eyeglasses. The Mack and Chunga eyeglasses would often fall off during vigorous activity; thus there is no expectation of success in attaining applicant's objectives. Imagine a person swimming in the ocean with a pair of eyeglasses as shown by Mack or Chinga!

Also, there can be no expectation of success in making this combination as there is no room on Chinga for receiving a message and thus Chunga teaches away from the combination.

In contrast with the combination of these references, applicant's eye patch, missing from the references, with its double sided adhesive, will cling to the wearer's face and support the lens during vigorous activity.

Applicant respectfully submits that a rejection under 35USC 103 cannot be proper when the examiner is combining two references that teach away from applicant's invention.

“ A reference may be said to teach away [from applicant's invention] when a person of ordinary skill, upon reading the reference, would be discouraged from following the path

set out in the reference, or would be lead in a direction divergent from the path that was taken by the applicant.” In re Gurley, 31 USPQ 2d 1130 (Fed. Cir. 1994).

“It is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties and the problem it solves. In re Wright 6 USPQ 2<sup>nd</sup> 1959 (Fed. Cir. 1988).

Applicant respectfully submits that a rejection under 35USC 103 cannot be proper when the examiner is combining two references that teach away from applicant's invention.

Additionally, there is simply no room on the Chunga glasses to carry a visible message which applicant requires and thus the proposed combination would result in an inoperable combination.

“If the proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification..” Citing in re Gordon 221 USPQ 1125 (Fed Cir. 1984).

Furthermore, the examiner has failed to clearly articulate a reason why the combination of the references is obvious, as required by MPEP 2143 that states: "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit."

#### CLAIM 42

It is respectfully submitted that for the social context herein, providing a comic saying or flirtatious conversation piece message enhances the social experience.

#### CLAIMS 45-48



The outer adhesive layer not only supports the lens but has the convenient dual function of receiving and supporting a label carrying the aforesaid message upon the eye patch.

#### CLAIMS 49 AND 43, 44

It is respectfully submitted that the use of an old discarded lens in applicant's eye patch is a new and unobvious use of an old lens that would otherwise be thrown away. Who would think of using her old normally discarded lens in this highly unusual manner? The user of applicant's novelty eye patch who uses an old discarded lens in the eye patch is not a manufacturer saving manufacturing costs as asserted by the examiner. The supplier of the eye patch does not supply the old discarded lens of the wearer. The wearer has already paid for her new up to date corrective lenses. This clever feature should be independently patentable and is not suggested by the references.

#### CLAIMS 55, 56

Claims 55 and 56 are quite similar to claim 41. While eye patches are widely understood to be flexible, this limitation has been dropped since it may be practical to provide an eye patch that is relatively ridged, which however may complicate having the eye patch fit securely upon the user's face. Also the fastening devices could constitute something other than adhesives like, for instance, elastic straps about the wearer's head.

Respectfully submitted,

---

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CLAIM APPENDIX (10/665,256)

41. A method for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses comprising the steps of:

(a) providing a person seeking to attract attention at socially interactive events with a flexible frameless eye patch with an aperture therein sufficient to enable said person to see through the aperture, and with a first adhesive layer on a first side of said flexible frameless eye patch for affixing said flexible frameless eye patch directly upon said person's face to maintain said eye patch in place during vigorous social activity and having a second adhesive layer on a second side of said flexible frameless eye patch adjacent said aperture for supporting an optical element upon said flexible frameless eye patch and over said aperture;

(b) placing an attention getting message of a type that invites social interaction and that is not a trademark or logo upon said second adhesive layer of said flexible frameless eye patch; and

(c) mounting an optical element over said aperture and upon said second adhesive layer on the second side of said flexible frameless eye patch.

42. The method of claim 41 wherein the attention getting message is a comic saying or flirtatious conversation piece message.

43. The method of claim 41 wherein said optical element is an old discarded corrective eyeglass lens belonging to said person, for creating a new use of said old discarded corrective eyeglass lens.

44. The method of claim 42 wherein said optical element is an old discarded corrective eyeglass lens belonging to said person, for creating a new use of said old discarded corrective eyeglass lens.

45. The method of claim 41 wherein step (b) is performed by attaching a label bearing said message upon said second side of said flexible frameless eye patch.

46. The method of claim 42 wherein step (b) is performed by attaching a label bearing said message upon said second side of said flexible frameless eye patch.

47. The method of claim 43 wherein step (b) is performed by attaching a label bearing said message upon said second side of said flexible frameless eye patch.

48. The method of claim 44 wherein step (b) is performed by attaching a label bearing said message upon said second side of said flexible frameless eye patch.

49. A method for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses comprising:

(a) providing a person seeking to attract attention at said socially interactive events with a flexible frameless eye patch having an attention getting device thereon and having an aperture therein sufficient to enable said person to see through the aperture, and with a first adhesive layer on a first side of said flexible frameless eye patch for affixing said flexible frameless eye patch directly upon said person's face to maintain said eye patch in place during vigorous social activity and having a second adhesive layer upon a second side of said flexible frameless eye patch adjacent said aperture for supporting an optical element upon said flexible frameless eye patch; and

(b) mounting an old discarded corrective eyeglass lens belonging to said person upon said second adhesive layer and over said aperture, for creating a new use of said old discarded corrective eyeglass lens.

55. A method for aiding a person seeking to attract attention at socially interactive events who may be self-conscious about wearing conventional eyeglasses comprising:

(a) providing a person seeking to attract attention at socially interactive events with a frameless eye patch with an aperture therein sufficient to enable said person to see through the aperture, and with a first fastening device for affixing said frameless eye patch directly to said person's face to maintain said eye patch in place during vigorous social activity and having a second fastening device for supporting an optical element upon said frameless eye patch;

(b) placing an attention getting message of a type that invites social interaction and that is not a trademark or logo upon the second side of said eye patch; and

(c) mounting an optical element over said aperture and upon the second side of said eye patch, wherein said optical element is an old discarded corrective eyeglass lens belonging to said person for creating a new use of said old discarded corrective eyeglass lens.

56. The method of claim 55 wherein said second fastening device constitutes an adhesive layer.

## EVIDENCE APPENDIX

None

**RELATED PROCEEDINGS APPENDIX**

**None**